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22850 7590 10/25/2007 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER O HERN, BRENT T	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/506,993
Filing Date: September 09, 2004
Appellant(s): NUN ET AL.

**MAILED
OCT 25 2007
GROUP 1700**

Harris A. Pitlick
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 7 September 2007 appealing from the
Office action mailed 30 April 2007

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US 6,783,807	Huffer et al.
US 6,800,354	Baumann et al.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

Claims 11-14 and 16-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Huffer et al. (US 6,783,807).

Regarding claim 11, Huffer ('807) teaches a molding comprising at least one surface having self-cleaning properties (*col. 3, ll. 53-55, col. 6, ll. 1-7, col. 4, ll. 20-22 and col. 9, ll. 57-61*) and surface structures with elevations (*col. 3, ll. 65-66*).

The phrases **“formed by directly embedding microparticles into the molding”** in claim 11, lines 2-3 and **“wherein the molding is produced by: accreting primary particles to form microparticles, wherein said microparticles have hydrophobic properties and said microparticles comprise agglomerates or aggregates of from 0.2 to 100 μ m, applying the microparticles to the inner surfaces of a mold, molding a molding composition, wherein the molding composition comprises at least one material comprising organic compounds and said molding composition is in softened or molten form, and thermally shaping the molding composition in the mold, and solidifying the molding composition to obtain the molding, wherein not more than 90% of the diameter of at least 50% of the microparticles are impressed into the surface of the molding which has not yet solidified, said microparticles are firmly held by the molding to anchor said microparticles into the molding after the molding is solidified, said molding has elevations formed by the microparticles and said molding has at least one surface having self-cleaning properties”** in claim 11, lines 3-19 are **process limitations** in product claims and hence not given any patentable weight since

Art Unit: 1794

patentability of a product does not depend on its method of production (*see MPEP § 2173.05(p)*).

Regarding claims 12 and 18, Huffer ('807) teaches a molding wherein the elevations have an average height of from 20 nm to 25 μm (*col. 3, ll. 65-66*) and an average separation of from 20 nm to 25 μm (*col. 3, ll. 66-67*).

Regarding claim 13, Huffer ('807) teaches a molding wherein the elevations have an average height of from 50 nm to 4 μm (*col. 3, ll. 65-66*) and/or an average separation of from 50 nm to 4 μm (*col. 3, ll. 66-67*).

Regarding claims 14 and 19, Huffer ('807) teaches a molding wherein the molding comprises microparticles and the microparticles are selected from the group consisting particles of silicates, minerals, metal oxides, metal powders, silicas, and mixtures thereof (*col. 4, ll. 6-12*).

Regarding claim 16, Huffer ('807) teaches a molding wherein the molding is a three-dimensional article selected from the group consisting of vessels, bottles, storage vessels, drums, measuring beakers, tanks and discharge aids (*col. 8, ll. 30-40*).

Regarding claim 17, Huffer ('807) teaches a molding comprising at least one surface having self-cleaning properties and surface structures with elevations (*col. 3, ll. 65-66*), wherein the molding comprises at least one material comprising organic compounds and the molding is capable of being in softened or molten form and of being thermally shaped (*See col. 4, ll. 25-40 and col. 5, ll. 87-24. Furthermore, all materials are capable of being softened and thermally shaped to at least a minimal degree.*).

The phrase **“wherein the surface structures are formed by hydrophobic microparticles embedded directly into the molding”** in claim 17, lines 4-5 are **process limitations** in a product claim and hence not given any patentable weight since patentability of a product does not depend on its method of production (see *MPEP* § 2173.05(p)).

Claim Rejections - 35 USC § 103

Claims 15 and 20 rejected under 35 U.S.C. 103(a) as being unpatentable over Huffer et al. (US 6,783,807) in view of Baumann et al. (US 6,800,354).

Huffer ('807) teaches the product discussed above, however, fails to expressly disclose wherein the product comprises impressed particles and the impressed particles are anchored with from 10 to 90% of their average particle diameter within the surface of the product.

However, Baumann (354) teaches self-cleaning particles on a substrate with a height of 0.5 to 15 μm (col. 5, ll. 13-17) which are anchored (col. 4, ll. 23-27, *embedded, thus anchored*), forming a layer with thickness of 5-1,000 nm (col. 8, ll. 29-39), which would obviously be anchored by at least 10% of the particle diameter for the purpose of providing a self-cleaning article (col. 2, ll. 66-67).

Therefore, it would have been obvious to one having ordinary skill in the art at the time applicant's invention was made to modify Huffer's ('807) structure with a self-cleaning surface wherein the particles are embedded by at least 10% of their diameter as taught by Baumann (354) in order to provide an article with a self-cleaning surface.

(10) Response to Argument

Appellant argues (p. 4, para. 4 to p. 5, para. 1 of Appellant's Brief filed 7 September 2007) that Applicant's process limitations distinguish Applicant's product from the prior art and Huffer ('807) teaches away from the "use" of a surface which can be softened or molten, or thermally shaped.

However, it is noted that Applicant's invention is directed to a molding product not towards a use, a process of making a product or an intermediate product. Applicant's claimed product is not patentable over of the prior art.

Furthermore, Applicant's claims do not present the above alluded to "use limitations". Additionally, Applicant's arguments attempting to distinguish the prior art by asserting its surface can be softened is misleading as the surface Applicant is alluding to is not the same surface as Applicant's claimed molded product but rather a surface of an intermediate product.

Furthermore, Huffer's ('807) self-cleaning surface of its polymeric molding having imbedded microparticles clearly has the ability to be softened and thermally shaped (See col. 9, ll. 57-61, col. 3, ll. 57-66, col. 7, ll. 46-65, col. 4, ll. 20-22, ll. 25-40 and col. 5, ll. 8-20.). Furthermore, it is noted that Huffer's ('807) polymeric coating, which is clearly moldable, with microparticles embedded therein is interpreted as being a molding with embedded microparticles.

Appellant concludes (p. 5, para. 1 of Appellant's Brief filed 7 September 2007) that protuberances cannot be embedded in the underlying parts.

However, it is noted that whether or not the protuberances of Huffer ('807) are embedded in an underlying part is not the issue at bar but rather Huffer's ('807)

Art Unit: 1794

teachings of Applicant's claimed structural limitations. Applicant's arguments are not germane to any issue at bar.

Furthermore, it is noted that Huffer ('807) teaches a molding comprising at least one surface having self-cleaning properties wherein the protuberances (particles) are from 100 nm to 50 μm in height and are embedded within the polymeric organic-containing self-cleaning molding having a thickness from 1 to 100 μm (See col. 9, ll. 57-61, col. 3, ll. 57-66, col. 7, ll. 46-65, col. 4, ll. 20-22, ll. 25-40 and col. 5, ll. 8-20.). Thus, particles with the above dimensions and polymeric organic molding material with the above thickness provide for any degree of embedding for the purpose of providing a self-cleaning affect.

Appellant argues (p. 5, para. 2 of Appellant's Brief filed 7 September 2007) that Huffer ('807) does not teach independent claim #17 because Huffer's ('807) protuberances are not embedded into the surface being softened, or molten form.

However, it is noted that said limitations are discussed above with respect to claim #11. Furthermore, Huffer ('807) clearly teaches particles embedded within the organic moldable polymeric material which clearly has the ability to be soft or molten.

Appellant argues (p. 5, para. 4 to p. 6, para. 1 of Appellant's Brief filed 7 September 2007) that Huffer ('807) does not teach claims dependent claims 15 and 20 because neither Baumann ('354) nor Huffer ('807) teach directly embedding particles into the molding.

However, it is noted that Baumann ('354) teaches self-cleaning particles on a substrate with a height of 0.5 to 15 μm (See col. 5, ll. 13-17.) which are anchored (See

Art Unit: 1794

col. 4, ll. 23-27, embedded, thus anchored.), forming a layer with thickness of 5-1,000 nm (See col. 8, ll. 29-39.). Furthermore, as discussed above, Huffer ('807) clearly teaches particles embedded into the organic polymeric molding. Thus, Applicant's interpretation of the references is not accurate.

For the above reasons, it is believed the rejections should be sustained.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Brent T. O'Hern, Examiner

Brent T. O'Hern 10-18-2007

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